REMARKS

Claims 1-21 are pending in the application. Claims 1-21 are rejected. Claims 2-3, 7, 9-10 and 16-17 have been canceled in this Response.

Drawing Amendments

Examiner objected to the drawings for failing to show certain referenced numerals contained in the specification.

Applicant has enclosed a Replacement drawing sheet for Figure 4 to include the omitted reference signs mentioned in the description.

Claim Rejections – 35 U.S.C. § 112

Claim 7 is rejected under 35 U.S.C. §112, second paragraph. Claim 7 has been canceled in this response.

Claim Rejections – 35 U.S.C. § 102

Claims 1-21 are rejected under 35 U.S.C. §102(e) as being anticipated by U.S. Publication No. 2003/0078964 to Parrella et al. (hereinafter "Parrella").

Independent claims 1, 8, and 15 have been amended to incorporate selected limitations previously recited in dependent claims 2-3, 9-10 and 16-17. In particular, independent claims 1, 8, and 15, as amended herein, now recite that the database server is operable to examine a flag in a data field corresponding to determine whether the most current version of a requested web page is stored in a cache in a web server. This limitation relating to the examination of a flag in a data field was previously recited in dependent claims 3, 10, and 17, which were rejected by Examiner under 35 U.S.C. §102(e) as being anticipated by Parrella. In the rejection of these claims, Examiner stated that Parella teaches a system that is operable to examine "a data field in said web cache table corresponding to said requested web page to determine if a flag in said data field has been set to a value indicating that the version of the requested web page stored on said web server is not the most current version of said requested web page." As a basis for this rejection, Examiner refers to paragraph 65 of Parella and states that Parella "inherently" performs the step of examining the data field for updates. Applicants respectfully submit that Parella does not teach the

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aforementioned feature of examining a flag in a data field to determine if the version of a web page stored on a web server is the most current version of that web page. For convenience, the full text of paragraph 65 of Parella is set forth below:

> [0065] The Web server hosts one or more web sites that are attached to the Internet. The Super Host, i.e., Super Host 538, replies to requests made from the Super CO Concentrators, e.g., 536. Each time a request is made for a down load of any web site hosted on the Web server, the Super Host 538 retrieves the web pages from the Web server and compresses and packages the contents before sending it to the requesting Super CO Concentrator. This improves the efficiency of the web transport by the effective compression rate and by sending a single data block for all the requested web page data. Alternatively, rather than sending all of the data of the requested web page as one single data block, the Super Host may forward information to the Super CO Concentrator as more than one data block to maximize overall transmission performance. In one embodiment, the Super Host may forward the initial HTML document while simultaneously retrieving, packaging and compressing the remaining data. The remaining data can in turn, be forwarded as a single data block or as multiple blocks. The decision to forward as a single block or multiple blocks is based on a number of factors used to minimize the overall transmission time by balancing the data delivery rate to the Super User with the data retrieval rate by the Super Host. Each piece of information is analyzed and compressed using techniques that best perform for the specific type of data. As each Super CO Concentrator request is received, the Super Host records the IP address of the Super CO Concentrator. The Super Host checks the web sites contained on the Web server and sends notifications of any changed web pages to any Super CO Concentrator that has requested data from the web sites historically. This allows the Super CO Concentrator to know when it needs to refresh its version of the Web site and minimizes Web traffic by allowing the Super CO Concentrator to service user requests for web pages directly from its version of the web page in the Super CO Concentrator's cache. The only time the Super CO Concentrator version of the web page needs to be refreshed is when it has changed. This allows for minimized traffic from the web hosting sites to the ISP sites. There are many ISP sites accessing data at each web site. This is a step in moving web sites to the outer fringe of the Internet and bringing compression and packaging to the inner workings of the Internet. The challenge of moving web sites to the outer fringes of the Internet is to make sure data is current, the interlocking of the Super Module caches insures this.

The cited paragraph from Parella is silent with regard to the specific manner in which the version of any web page is determined or how the decision is made to update any web page.
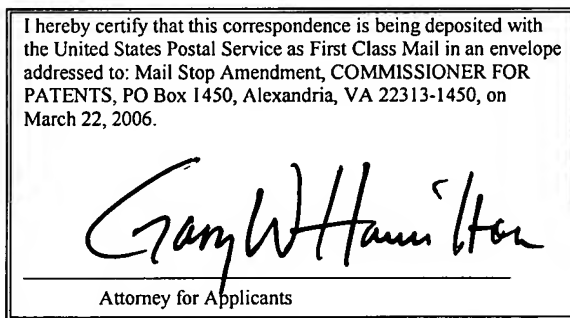
At a minimum, Examiner has failed to satisfy the requirements of 35 U.S.C. §102(e) with regard to the rejection of claims based on "inherency" of a feature not actually shown in a reference. In particular, it is necessary for Examiner to provide an explicit rationale or evidence supporting the assertion of a reference based on inherency. The fact that a certain result or characteristic <u>may</u> occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1534, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993; *In re Oelrich*, 666 F.2d 578, 581-82, 212 USPQ 323, 326 (CCPA 1981). "To establish inherency, the extrinsic evidence 'must make clear that the missing descriptive matter is necessarily present in the thing described in the reference, and that it

would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.' " *In re Robertson,* 169 F.3d 743, 745, 49 USPQ2d 1949, 1950-51 (Fed. Cir. 1999) (citations omitted) "In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic <u>necessarily</u> flows from the teachings of the applied prior art." *Ex parte Levy,* 17 USPQ2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original).

Applicants respectfully submit that independent claims 1, 8, and 15, as amended, are allowable and that the claims dependent on the aforementioned claims are allowable as being dependent from an allowable base claim.

CONCLUSION

In view of the amendments and remarks set forth herein, the application is believed to be in condition for allowance and a notice to that effect is solicited. Nonetheless, should any issues remain that might be subject to resolution through a telephonic interview, the examiner is requested to telephone the undersigned.

I hereby certify that this correspondence is being deposited with the United States Postal Service as First Class Mail in an envelope addressed to: Mail Stop Amendment, COMMISSIONER FOR PATENTS, PO Box 1450, Alexandria, VA 22313-1450, on March 22, 2006.

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Respectfully submitted,

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